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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,692	02/10/2004	Knut M. Schwarz	H-1351 CIP	9187
7590 William W. Jones 6 Juniper Lane Madison, CT 06443			EXAMINER CHAN, KO HUNG	
			ART UNIT	PAPER NUMBER
			3632	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/775,692

Applicant(s)

SCHWARZ, KNUT M.

Examiner

Korie H. Chan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

Claims 11-16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ognier (US patent no. 5,918,844) in view of Osypka (US patent no. 6,684,109). Ognier discloses a holding and positioning assembly for securing surgical accessory instruments in place during surgery, the assembly comprising a swiveling and rotatable seat (105b) for the accessory instruments, the seat including means for gripping the instrument (103) and the seat being linked to a mechanical arm (105a and 106) via a multi-directionally movable joint mechanism (108a, 109), the mechanical arm being operative to prevent body cavity wall rupture during orientation of the instrument in the body cavity, and the mechanical arm being manually maneuverable to alter the position of the seat in the assembly; wherein the mechanical arm is sufficiently flexible so as to bend before the tensile strength of the tissue of a surgical patient is reached during maneuvering of the assembly during surgery; the flexibility of the mechanical arm is controlled by the material that the mechanical arm is formed from; wherein the flexibility of the mechanical arm is the result of swiveling joints (108, 108a) formed in the mechanical arm; wherein the swiveling joints are biased by torsion springs (40c, figure 5); wherein rupture of the body cavity wall is prevented by restricting the degree of operative motion of the mechanical arm. Regarding claim 16, Ognier's mechanical arm

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is of a ball joint which is known to be rotatable around 360 degrees and which means it is inherently capable of degree of operative motion to a cone having angle of no more than 35 degrees. It would have been a matter of obvious mechanical expedient to have restricted the movement of the mechanical arm to a cone of no more than 35 degrees as Ognier's device is inherently capable of such movement for the purpose intended.

However, Ognier does not disclose the arm is of elastic mechanical arm having resilient connectors of elastomeric material or torsion spring.

Arm of elastic type made of elastomeric material such as torsion spring are old and well-known in the art. Osypka teaches a surgical device having a mechanical arm of elastic type made of elastomeric material such as torsion spring (col. 7, lines 58-60, 312, figure 6) to better aid in the active deployment of the arms from a constrained position to an unstressed deployed position (col. 7, lines 53-55). It would have been obvious to one of ordinary skill in the art to have modify the arm and joint of Ognier such that it is of an arm of elastic type made of elastomeric material such as torsion spring to better aid in the active deployment of the arms from a constrained position to an unstressed deployed position as taught to be desirable by Osypka. Such modification would have involved a mere substitution of one well-known type of mechanical arm with another which is thought to be well within the ambit of one of ordinary skill in the art.

Response to Arguments

Applicant's arguments filed 9/11/2006 have been fully considered but they are not persuasive. The rejection of 35 U.S.C. 112 second paragraph and 35 U.S.C. 102 (b) has been withdrawn. The 35 U.S.C. 103 rejection stands. Applicant argues that

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against Ognier that examiner has mislabeled Ognier as being elastic but rather flexible. Examiner agrees that Ognier's arms is flexible and not elastic and that is why the teaching of the secondary reference of Osypka was brought forth to teach and demonstrate that in the art of surgical support, providing elastic arms of elastic material is conventional and well-known. Applicant argues that regarding claim 12, Ognier does not show a coil spring. Examiner has demonstrated that Osypka teaches elastic arms that maybe made of springs of the coil type (Col. 7, lines 65-68). In the above arguments, applicant is attacking the references individually and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion or motivation to do so is found in the references themselves. Ognier demonstrates a surgical arm which is preferred to have the features of flexibility and universal joints for enhanced movement during surgical procedures. Osypka teaches the movation and advantage of having elastic arms to provide elasticity which provides flexibility and

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universal joint in surgical arm support. Both of the same surgical art. To substitute one known arm for another would have been and well within the ambit of one of ordinary skill in the art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Korie H. Chan whose telephone number is 571-272-6816. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on (571)272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Korie H. Chan
Primary Examiner
Art Unit 3632

khc
February 27, 2007